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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,720	01/28/2005	Takashi Kawakami	261514US6PCT	7446
22850 7590 08/27/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER HEYI, HENOK G				
ART UNIT 2627		PAPER NUMBER		
NOTIFICATION DATE 08/27/2009		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/522,720

**Applicant(s)**

KAWAKAMI, TAKASHI

**Examiner**

HENOK G. HEYI

**Art Unit**

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 May 2009.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-10 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 19 September 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 05/28/2009 have been fully considered but they are not persuasive. Applicant argues that the arts of record do not disclose or suggest transferring audio data between a first recording medium and a second recording medium, without destruction of a data structure of the audio data. However, Kato teaches that the contents of the AV stream files and their associated database files recorded to the recording medium 10 can be properly managed to allow the user to easily copy desired AV stream files and their associated database files to another recording medium (see para [0660]).

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masaharu JP 2003-029795 A in view of applicant's admitted prior art of Fig. 3 and further in view of Kato US 2004/0213552 A1 (Kato hereinafter).

Re claim 1, 5 and 8, Masaharu teaches a data transferring system, method and a computer readable medium for transferring audio data between a first recording medium and a second recording medium (system which can transmit a music content from digital filing apparatus to digital player apparatus, para [0001]), comprising: a plurality of first sets defining albums, each of which includes at least one track of audio data (two or more musical pieces to a digital memory player from a personal computer, para [0002]), the albums being correlated with a plurality of content ID's identifying audio data that has been recorded on the first recording medium (It is judged whether capacity data and identification data which are contained in a selected favorite list file are in agreement with capacity data of a desorbed type memory of digital player apparatus, para [0009]), and a controlling portion for transferring all tracks of audio data contained in the first sets that contain audio data described in the second set from the first recording medium to the second recording medium without destruction of a data structure of the audio data, when audio data described in the second set are transferred to the second recording medium (the user needs to advance selection of a musical piece, and transmission, caring about the data volume of the musical piece used as a transmission plug until the memory of a digital memory player fills, para [0002]), wherein the same data structure of audio data on the first recording medium side is formed on the second recording medium based on the link between the play list and the plurality of content

ID's (It is judged whether capacity data and identification data which are contained in a selected favorite list file are in agreement with capacity data of a desorbed type memory of digital player apparatus, para [0009]) but Masaharu fails to explicitly teach the data transferring system comprising: a second set that describes the reproduction order of audio data contained in at least one first set and recorded in the first recording medium and that describes pointers to entities of audio data contained in each of the first sets. However, applicant's admitted prior art, Fig. 3, shows relation of albums and a play list according to an embodiment of the present invention as claimed in claim 1 and also shown in Fig. 52 of the specification. The only difference between Fig. 3 and Fig. 52 is that in Fig. 3, only songs that are part of the playlist are transferred while in Fig. 52 the whole album is transferred. To meet this deficiency of the admitted prior art, Examiner introduces Kato that teaches a transfer of not only playlist file but also the transfer of AV stream file and clip information file (see Fig. 61). Kato also teaches a method of transferring data without destruction of a data structure of the audio data (the contents of the AV stream files and their associated database files recorded to the recording medium 10 can be properly managed to allow the user to easily copy desired AV stream files and their associated database files to another recording medium, para [0660]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the known method of applying pointers and keeping the reproduction order in a second set while transferring data (both playlist file and other data) from a personal computer to another recording and reproducing medium or apparatus. The modification

would have been obvious because of the benefit of link pointers in the playlist while transferring data from personal computer to a recording and reproducing apparatus.

Re claim 2, Masaharu teaches the data transferring system according to claim 1, wherein the second recording medium is a detachable disc-shaped recording medium (desorbed type memory of digital player, para [0009]).

Re claim 3, Masaharu teaches the data transferring system according to claim 1, wherein the second recording medium has identification information unique thereto (identification data of a desorbed type memory of digital player apparatus, para [0009]).

Re claim 4, Masaharu teaches the data transferring system according to claim 3, wherein the identification information unique to each recording medium is correlated with the first sets (identification data of a desorbed type memory of digital player apparatus, and a batch transmission means, it is judged whether capacity data and identification data which are contained in a selected favorite list file are in agreement with capacity data of a desorbed type memory of digital player apparatus and identification data, para [0009]).

Re claim 6, Masaharu teaches the data transferring method according to claim 5, wherein the second recording medium has identification information unique thereto (identification data of a desorbed type memory of digital player apparatus, para [0009]).

Re claim 7, Masaharu teaches the data transferring method according to claim 6, wherein the identification information unique to each recording medium is correlated with the first sets (identification data of a desorbed type memory of digital player

apparatus, and a batch transmission means, it is judged whether capacity data and identification data which are contained in a selected favorite list file are in agreement with capacity data of a desorbed type memory of digital player apparatus and identification data, para [0009]).

Re claim 9, Masaharu teaches the computer readable medium according to claim 8, wherein the second recording medium has identification information unique thereto (identification data of a desorbed type memory of digital player apparatus, para [0009]).

Re claim 10, Masaharu teaches the computer readable medium according to claim 8, wherein the identification information unique to each recording medium is correlated with the first sets (identification data of a desorbed type memory of digital player apparatus, and a batch transmission means, it is judged whether capacity data and identification data which are contained in a selected favorite list file are in agreement with capacity data of a desorbed type memory of digital player apparatus and identification data, para [0009]).

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HENOK G. HEYI whose telephone number is (571)270-1816. The examiner can normally be reached on Monday to Friday 8:30 to 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Henok G Heyi/  
Examiner, Art Unit 2627

/Joseph H. Feild/  
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